

REMARKS

In paragraph 1, on page 2 of the Office Action, the Examiner indicates that Claims 1-50 are pending, and Claims 49-50 have been withdrawn, as directed to a non-elected invention.

However, the Examiner has failed to appreciate that in the Amendment filed February 6, 2003, Claims 15 and 45 were cancelled and Claims 51-76 were added. In any event, Claims 16, 35, 44, 46-48 and 51-76 are cancelled herein. Hence, the Examiner is requested to correct the status of the pending claims.

In paragraph 4, on page 2 of the Office Action, the Examiner rejects Claims 1-48 under 35 U.S.C. § 112, first paragraph as containing new matter.

Specifically, the Examiner states that the expression “represented by nucleotides 1-98 of SEQ ID NO:52-54” is not supported in the specification.

In view of the amendments to Claim 1, Applicants respectfully submit that the Examiner’s rejection has been rendered moot.

In paragraph 7, on page 4 of the Office Action, the Examiner rejects Claims 1-16, 22-23 and 35-46 under 35 U.S.C. § 112, first paragraph.

Specifically, the Examiner states that while the specification is enabling for detecting prostate or liver cancer by differential methylation analysis of the GST-Pi gene, such does not provide enablement for detecting any cancer based upon differential methylation analysis of the GST-Pi gene.

The claims have been amended to limit the cancer to liver or prostate cancer, thereby rendering moot the Examiner’s rejection.

In paragraph 8, on page 10 of the Office Action, the Examiner rejects Claims 1-48 under 35 U.S.C. § 112, second paragraph.

Specifically, the Examiner states that the claims are indefinite because it is unclear what “within the region of the GST-Pi gene and/or its regulatory flanking sequences defined by (and inclusive of) CpG sites -43 to +55” encompasses. The Examiner contends that it is unclear whether the application is limited to -43 to +55, or whether the amplified region must merely include these CpG sites.

In view of the amendments to Claim 1, Applicants respectfully submit that the Examiner’s rejection has been rendered moot.

In paragraph 9, on page 11 of the Office Action, the Examiner rejects Claims 1, 3, 14-25, 35-39 and 44-47 under 35 U.S.C. 102(b) as being anticipated by Lee et al.

The Examiner notes Applicants’ argument that Lee et al relies on a preceding exhaustive digestion step which is selective. However, the Examiner contends that the claims as broadly written are drawn to “comprising” methods, which include additional steps, and therefore the additional step of digestion prior to amplification is encompassed by the present claims.

In view of the amendments to Claim 1 to exclude the exhaustive digestion step taught in Lee et al, Applicants respectfully submit that the Examiner’s rejection has been rendered moot.

In paragraph 11, on page 13 of the Office Action, the Examiner rejects Claims 2, 4-13 and 40-41 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al in view of Herman et al.

The Examiner notes Applicants’ arguments that Herman et al is based upon primers that distinguish between methylated and unmethylated CpG sites and that this is not abnormal methylation. However, the Examiner states that methylation and unmethylation are indicative of abnormal methylation patterns.

In view of the amendments to Claim 1 to exclude the exhaustive digestion step taught in Lee et al, Applicants respectfully submit that the Examiner’s rejection has been rendered moot.

In paragraph 12, on page 20 of the Office Action, the Examiner rejects Claims 26-29 under 35 U.S.C. § 103 as being unpatentable over Lee et al in view of Herman et al and in further view of Jhaveri and Morrow et al.

In view of the amendments to Claim 1 to exclude the exhaustive digestion step taught in Lee et al, Applicants respectfully submit that the Examiner's rejection has been rendered moot.

In paragraph 13, on page 22 of the Office Action, the Examiner rejects Claims 30-34 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al in view of Tchou et al.

In view of the amendments to Claim 1 to exclude the exhaustive digestion step taught in Lee et al, Applicants respectfully submit that the Examiner's rejection has been rendered moot.


In view of the amendments to the claims and the arguments set forth above, reexamination, reconsideration and allowance are respectfully requested.

The Examiner is invited to contact the undersigned at his Washington telephone number on any questions which might arise.

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Respectfully submitted,



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